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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,621	07/27/2000	Conrad V. Anderson	55679USA2A.002	2487

7590

12/10/2002

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EXAMINER

PURVIS, SUE A

ART UNIT

PAPER NUMBER

1734

DATE MAILED: 12/10/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-12

Office Action Summary

Application No.

09/626,621

Applicant(s)

ANDERSON ET AL.

Examiner

Sue A. Purvis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 26-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-25, drawn to method of providing a composite image on a substrate, classified in class 156, subclass 64.
 - II. Claims 26-33, drawn to an image graphic kit, classified in class 428, subclass 542.2.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions II and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product does not have to be used in a manner as detailed in the process.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Kevin W. Raash on 03 December 2002 a provisional election was made with traverse to prosecute the invention of I, claims 1-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 26-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 and 9-23 rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Krawczyk (US Patent No. 5,252,166) and Jensen, Jr. (US Patent No. 4,795,513).

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Pages 1 and 2 of the instant specification teaches that previously a composite image was formed on the surface of a substrate manually by a skilled applicator who would pull or stretch each film slightly, thus varying its tension, as it was being applied to maintain registration between the different panels used to form the composite image.

The admitted prior art does not teach using registration marks on the film and aligning those registration marks up.

Krawczyk discloses a method of mounting multiple plastic sheets where the dimensions of the composite image are greater than the dimension of the plastic sheets. (Figures 17 and 18). Each portion has guidelines thereon for which are used to help align the design properly.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include guides or registration marks in the method of the admitted prior art, because while in some instances a skilled artisan only needs to look at the composite image in order to align it properly images on separate sheets, there are instances where guidelines or registration marks would be helpful in aligning images on separate sheets as taught by Krawczyk.

The admitted prior art in view of Krawczyk does not teach varying the tension on the second film along the length of the film to help ensure the marks are aligned properly.

Jensen, Jr. teaches forming a two-layered composite, 16, formed by the lamination of paper web, 14, with film web, 12. The paper layer, 14, has a perforated pattern, 24, and the plastic layer, 12, has a target area, 28, positioned in registration with the area, 24. A register control system is adapted to provide proper registration between the perforated pattern, 24, and

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the target area, 28. During operation the length of the film web is stretched or shrunk in order for it to be properly aligned with the paper web. (Col. 7, lines 12-65).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the tension on the length second web thus stretching or shrinking the space between the registration marks, because Jensen, Jr. teaches such steps are known ways of aligning webs.

Regarding claim 2, applicant sets out in claim 1, that the second film is dispensed “under tension along the length of the second film”; claim 2 states that this tension is “continuously applied to the second film during dispensing.” As a film is dispensed “under tension” it seems to the examiner that tension must be applied continuously for the “length” of the film to be under tension as stated in claim 1. This is shown in Jensen and admitted in the applicant’s art. When a film is dispensed or applied to a substrate, it must be so under a certain amount of tension, otherwise the film would become loose and bunch when adhered to another sheet, thus resulting in an undesirable outcome. Applicants own art admits a manual tensioning means, Jensen also has a tensioning means as shown in Figure 1 of Jensen. The webs are fed around cylinders (not numbered) which helps to maintain tensioned web, then through nip (62) which engages the web and varies the rate of transfer, thus controlling the tension in the web.

Regarding claim 3, Krawczyk and Jensen disclose using reference marks for alignment purposes.

Regarding claims 4 and 5, reference marks must be visible in order to allow for proper alignment and aligning the reference marks of the two films is done in Krawczyk and Jensen.

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Regarding claim 6, it is within the purview of the artisan to remove registration marks if less reference marks are desired by the artisan. It is also preferable to an artisan to have reference marks which are not seen or at least hardly noticed in the final product. In Krawczyk, one embodiment discusses how the guidelines or reference lines are easily removable because they are made with an erasable marker. (Col. 16, lines 43-47). The artisan has no desire for the marks created for the sole purpose of lining up sheets of material to be noticed after installation is complete, thus they would either make the references so small that they are barely noticeable or have the capability of removing mark, as shown in Krawczyk.

Regarding claims 7 and 24, when joining two films together the films are stretched so that the registration marks line up, as a result one film may have a bit of excess which would result in removing a portion of the film along with the registration marks thereon. There could be a number of reasons for such an occurrence, such as one film's supply is greater than the other or the supply appears to be the same at first but by stretching the film to line up the references marks, the stretched film ends up having excess film. Another possibility is that the film is removed for the sole purpose of removing the reference marks, and this is an obvious alternative to washing off the reference marks and is also shown in Krawczyk. The pelican design in Figure 18 shows the design with the top sheets attached, the top sheets contain the guidelines. Once the adhesive is hardened, those top sheets are removed, thus the guidelines are removed. Thus it is the position of the examiner that to remove part of the sheet to remove the registration marks is within the purview of the artisan. This is also shown in a Hensley et al. (US Patent No. 6,354,984 B1) where reference marks are preferably confined inside trim areas (79) such that the cutting out of a respective trim area simultaneously (i) creates a desired new element of the work

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piece, namely the leg cut-out, and (ii) removes the reference mark which was used to register the graphic to the pad. (See Figures 3, 4, and 6; Col. 16, lines 65-68).

Regarding claims 10 and 12, invisible and washable registration marks are within the purview of one having ordinary skill in the art, because it would be preferable that the alignment marks not be intrusive to the composite image. Krawczyk discloses washable reference marks as mentioned above.

Regarding claim 13, Krawczyk shows the use of a liner and having a film attached to a liner, especially where one side of the film is adhesive is within the purview of one having ordinary skill in the art. The liner prevents the film from adhering to undesirable objects.

Regarding claim 14, it is within the interests of the artisan to distribute the reference marks in regular intervals. The other option being irregular intervals which would not serve the purpose the artisan had designed the registration marks for. This is introduced in the applicants own admitted prior art as well as in Krawczyk and Jensen. (See Figure 2 of Jensen).

Regarding claim 15, storing film on a roll is well known and conventional as seen in Jensen.

Regarding claim 16, the reference marks would act as orientation indicators since they enable the films to line up properly.

Regarding claim 17, a direct result of aligning the reference marks is the alignment of the portions of the composite image. The admitted prior art uses just the composite image for this alignment while Krawczyk and Jensen show that registration marks are another way of achieving the same result. Thus the alignment of the registration marks of the admitted prior art in view of

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Krawczyk and Jensen would result in the composite image being aligned and registered across the width of the film.

Regarding claim 18, Jensen teaches control means that detects the distances between the reference marks in order to ensure the film is lined up properly. In determining the distance, as a result the “distance between a leading edge and a trailing edge” of the marks is found.

Furthermore, since the web is in tension across its width, that distance is indicative of the position of the composite image across the width of the web, to be otherwise would mean that one side of the web is stretched while the other being relaxed, thus creating a skewed web.

Regarding claim 19, applicant’s own admitted prior art states the skilled applicator will stretch or pull each film slightly as it is applied to the substrate in order to maintain registration between the different film panels.

Regarding claim 20, it is noted the film in Jensen, Jr. is fed in roll form, furthermore typically wallpaper or carpet, items which are applied to a static structure such as the instant invention, are typically stored in roll form.

9. Claims 8 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Krawczyk and Jensen as applied to claims 1, 5-7, 23, and 24 above, and further in view of Shannon (US Patent No. 4,806,184) or Fritz (US Patent No. 1,498,618).

Admitted prior art in view of Krawczyk and Jensen does not show removing the film before it is applied to the substrate is a matter of choice and within the purview of one of ordinary skill in the art. The choices are before or after and the artisan would know when it is preferable to remove any excess. Mitchell (US Patent No. 4,490,198) shows the excess material being trimmed after it is applied to the substrate. In particular, however, Shannon discloses that

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the material is cut to the desired length before application to the substrate. Fritz, mentioned in Shannon, also teaches to cut the sheet before applying to a substrate.

It would have been obvious to one having ordinary skill in the art at the time the invention was made when the film should be cut, because Shannon and Fritz both teach the film being trimmed before applying the film to the substrate. Thus to do so is within the purview of the artisan.

10. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Krawczyk and Jensen as applied to claims 1 above, and further in view of Easter (US Patent No. 4,620,888) or Roch (US Patent No. 5,138,667).

The admitted prior art uses the visible images for alignment purposes, Krawczyk, as discussed above, uses marks which are washable, so that they do not later interfere with the images. The marks (19) in Jensen are visible to the photoelectric eye (52). (Col. 7, lines 7-10).

Registration marks, such as those in Jensen, are designed to be unnoticed to the ordinary observer. This is further shown in Easter and Roch where the marks are "invisible". See claim 3 of Roch and column 5, lines 60-68 of Easter.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use invisible marks for registration purpose of both first and second films, because as shown in Easter and Roch these types marks are known and used in the art. They are used to align materials without interfering with the overall appearance.

11. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Krawczyk and Jensen as applied to claims 1 above as applied to claim 1 above, and further in view of Shannon (US Patent No. 4,806,184).

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A length of 5 meters and 10 meters is within the purview of one having ordinary skill in the art. The admitted prior art states 3 meters, however an artisan would know that the longer the length of the web, the less likely two webs will need to be used to cover a single surface and less chance for improper alignment. Shannon discloses a wallpaper applicator. Wallpaper is applied to rooms of varying sizes. As shown in Figure 14 of Shannon, the wallpaper is fed from a roller and placed side by side. This length of the material on the roll is not disclosed, but considering how the material is used in Shannon, it is the position of the examiner that the roll of material is more than 3 meters, because it is reused and an artisan would optimize the use of the device by making the roll as large as possible, thus minimizing the time it would take to refill the roll. Furthermore, the image on the wallpaper in Shannon is aligned as seen Figure 14.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the film as long as the skilled artisan needed for the purpose so desired. For instance, Shannon's supply is greater than the surface covered and the material along with the image is aligned. Methods which utilize a longer film, although not for aligning as in the instant invention, are Cousineau (US Patent No. 6,024,821) and Siker (US Patent No. 4,049,479). These references are only pulled to show that using a continuous sheet with an image thereon is known in the art.

Response to Arguments

12. Applicant's arguments filed 27 November 2002 have been fully considered but they are not persuasive.

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13. Regarding the new documents cited in the previous office, the use of those documents by themselves is not sufficient reason for withdrawal of finality. The documents were relied upon principally to show that the material in the claims is considered to be “common knowledge” and therefore within the purview of the artisan. (See MPEP §2144.03). The examiner failed to address these claims properly in the rejection however, which is why finality has been withdrawn. The rejection was expanded for clarification purposes.

14. Examiner disagrees that the proposed combination of admitted prior art, Krawczyk, and Jensen would change the principle operation of the prior art being modified. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

15. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the need to align substrates with an image thereon is admitted in the prior art. A skilled applicator would stretch or pull the sheet to ensure proper alignment. Krawczyk and

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Jensen do the same thing, only they teach using registration marks instead of the images on the articles.

16. While the applicant does not argue that Krawczyk and/or Jensen are nonanalogous art, the argument “that one skilled in the art would not have been motivated to look” at these two references in combination with the admitted prior implies that these are nonanalogous.

Therefore the examiner would like to remind the applicant that it has been held that a prior art reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Krawczyk and Jensen teach using registration marks for alignment purposes which is an issue in the admitted prior art, which relies solely on the images on the film.

17. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

18. In response to applicant's argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., tension is applied only along the length of the film) are not recited in the rejected claims. Although the

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claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

19. Regarding applicant's argument with respect to claims 6 through 8, the applicant's "film" is set forth in the admitted prior art. The "tile" in Krawczyk is equivalent to the "film" because the manner in which the two are used is the same. "Film" is aligned with "film" in the admitted prior art and "tile" is aligned with "tile" in Krawczyk. Applicant is bodily incorporating the structure of Krawczyk into the admitted prior art. It is the combined teachings that the examiner is using. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

20. Regarding applicant's argument with respect to claims 7 and 24, the rejection above does address removing a "portion of the film."

21. Regarding applicant's argument with respect to claims 8 and 25, the rejection above discusses removal "before" the film is applied to a substrate.

22. Regarding applicant's arguments with respect to claims 9-12, in particular, regarding invisible registration marks, invisible registration marks would be useless, they must at some point be readable by an individual or a machine. In Jensen registration marks (19) which are visible to a photoelectric eye (52). While Jensen does not specifically say it, it is doubtful that those marks are visible to the naked eye. (Col. 7, lines 10-25). The rejection above has been expanded to address this issue. As for Krawczyk teaching removing marks from "tiles" not "films", see paragraph 18.

23. Regarding applicant's arguments with respect to claims 14, it is the examiner's position that using regular intervals for registration marks is well known and conventional. This is shown in Jensen. The idea of using regular intervals is supported by Krawczyk, because the spacing of

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the intervals is well within the purview of the artisan. For additional support to show that spacing marks at regular intervals is well known and conventional, the examiner is citing three additional references: (1) in Bauknecht (US Patent No. 5,695,106) see Figure 3 and column 5, lines 47-64; (2) in Anderson et al. (US Patent No. 5,447,486) see column 6, lines 51-68 and column 7, lines 1-22; and (3) in Bradshaw (US Patent No. 5,431,763) see Figures 1 and 2, column 2, lines 20-24, and column 4, lines 21-29.

24. In response to applicant's argument for claim 18, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., detecting the leading and trailing edges of the second registration marks) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

25. Regarding applicant's arguments with respect to claims 19, panels are only disclosed in Krawczyk, applicant's own admitted prior art teaches film being applied under tension.

Conclusion

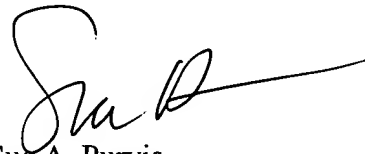
26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goodhill et al. (US Patent No. 6,450,644 B1), Inada (US Patent No. 6,452,147 B1), and Gough (US Patent No. 4,857,745) contain details regarding registration marks and their use.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is 703-305-0507. The examiner can normally be reached on Monday through Thursday 8am to 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rick Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.



Sue A. Purvis
Examiner
Art Unit 1734

sp
December 4, 2002



RICHARD CRISPINO
SUPERVISORY PATENT EXAMINER
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